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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,325	12/03/2003	John Kirchgeorg	05471.00017	5959
22908	7590	11/06/2006	EXAMINER	
BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606			SCHAETZLE, KENNEDY	
			ART UNIT	PAPER NUMBER
			3766	

DATE MAILED: 11/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/727,325

Applicant(s)

KIRCHGEORG ET AL.

Examiner

Kennedy Schaetzle

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: as per 37 CFR 1.177, the specification must include a sentence identifying each reissue application by relationship, application number, and filing date. The applicant has not provided the filing dates.

Appropriate correction is required

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the oximeter (claim 15, etc.) and capnometer (claim 19, etc.) must be shown or the feature(s) canceled from the claim(s). It is noted that while Fig. 4 shows oximeter controlling structure and a general reference to sensors 107, it does not show any reference to the oximeter or capnometer itself. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Recapture

3. Claims 11-29 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to claim subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope of claim subject matter surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The applicants' omission of the breathable oxygen delivery system amounts to a broadening of the claim. This subject matter was previously surrendered by the applicants in the prosecution of the original application (09/151,300). The amendment submitted December 20, 2000 adding the limitation was necessary to overcome the rejection issued in view of the Safar (Pat. No. 5,308,320) reference. On page 3 of the Remarks associated with this amendment, the applicants argue that Safar relates to a device for oxygenating blood during a bypass operation. The applicants responded by amending the claims to specify that the "gas dispensing device" is in fact a breathable oxygen delivery system. Such a change is argued to "...clearly distinguish the oxygenation system disclosed by Safar, which oxygenates extra-corporeal blood directly during bypass surgery or the like. Obviously the system of Safar does not represent a 'breathable oxygen delivery system' of the type contemplated by the invention."

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 11-29 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-22 of copending Application No. 10/727,327. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention's claims are merely broader in scope than those presented in the '327 application. If the applicant were to receive a patent on the more specific embodiment, he would not be entitled to a patent for the generic or broader invention (see *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993)).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 11-29 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 11-20 of U.S. Patent No. RE38533 in view of Arand et al.. The present invention's claims are broader than that of the '533 patent with the exception of the recitation concerning the use of at least one measurement system. Arand et al., however, teaches that an oximeter may be

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employed in conjunction with a defibrillator system as set forth below in the rejection under 35 U.S.C. §103. It is well-known that such information is diagnostically important when determining the appropriate course of defibrillation therapy. To include a measurement system as recited would have therefore been considered a matter of obvious design by those of ordinary skill in the art.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arand et al. (Pat. No. 6,021,349) in view of Olson et al. (Pat. No. 5,645,571) and Snyder et al. (Pat. No. 6,356,785).

Regarding claim 11, Arand et al. disclose a multi-component medical system comprising a defibrillation system 10, at least one measurement system which measures at least one of blood or gas content, saturation, affinity or perfusion (see col. 5, lines 36-39), and a unitary casing (see Fig. 2) that can easily be carried by a single hand (note Fig. 1 and the handle shown in Fig. 2). While Arand et al. do not explicitly refer to the unitary casing as housing the measurement system, Olson et al. disclose a related portable defibrillator that includes a compartment 26 for storing the electrodes as shown in Fig. 2. It is of general knowledge in the field of portable emergency medical equipment to ensure that all of the necessary system components are stored together and readily accessible to the emergency operator when deploying any medical device in a critical emergency situation. Snyder et al. in fact teach that portable defibrillator systems may include oximeters and other data gathering sensors that may be integral with the defibrillator system (col. 9, lines 8-33). The safety of the patient depends on avoiding complications and confusion resulting from missing equipment capable

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rendering the device ineffective or inoperative. Any person of ordinary skill in the art recognizing that prior artisans have taught the use of compartments for storing detachable sensing/shocking electrodes so as to ensure the electrodes are available for use when needed, and given the teaching that other sensing devices like oximeters may be made integral with portable defibrillator systems, would have seen the obviousness of also including the oximeter of Arand et al. into the casing.

Regarding claims 18-22, 25, 26, 28 and 29, as per the applicants' admission in the present specification section entitled: "Description of the Related Art" (col. 1, lines 21-35), the determination of oxygen and/or carbon dioxide levels such as may be obtained through oximetry and capnography devices, is known in the art and can provide critical information to on-site emergency medical personnel. Arand et al. echo this sentiment by teaching that the portable AED may incorporate an oximeter sensor that can be plugged into the housing as discussed above, with Synder et al. teaching that additional measurement devices (including a pulse oximeter as claimed in claim 18) may be made integral with the portable system, and Olson et al. disclosing the use of a compartment to hold measurement devices when not in use. To include a known capnometer (the examiner considers a capnometer to be patentably indistinct from an oximeter or other blood/gas parameter measurement device as evidenced by the lack of an election of species requirement) within the casing to measure carbon dioxide levels would have therefore been considered a matter of obvious design by those of ordinary skill in the art desirous of such useful information.

Claims not specifically addressed above are considered to be clearly shown by the base reference.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kennedy Schaetzle whose telephone number is 571 272-4954. The examiner can normally be reached on M-F from 9:30 -6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on M-F at 571 272-6996. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KJS
October 31, 2006



KENNEDY SCHAETZLE
PRIMARY EXAMINER